

Application Serial No. 10/516,694
Amendment Dated June 12, 2006
Reply to Office Action Dated January 10, 2006

Remarks

Claims 1-12 are pending.

Claims 1-12 stand rejected.

Claims 1, 6, 8, 9 and 11 are amended.

Claims 1-12 are submitted herein for review.

No new matter has been added.

In the first section of the Office Action, the Examiner has rejected claims 1, 6, 8, 9 and 11 under 35 U.S.C. § 112. Applicant has amended these claims accordingly and respectfully requests that the rejection of these claims be withdrawn.

In the second section of the Office Action, the Examiner has provisionally rejected claims 1, 2, 4, 6 and 11 under 35 U.S.C. 101. Although the Applicant realizes that the rejection is only provisional, amendments have been made to both the claims of the present application as well as the claims of C-I-P application 11/009,960 and respectfully submit that the claims of the two applications no longer claim the same invention. Applicant similarly notes that the inventions are not obvious over one another as well. Further review by the Examiner in view of the claim amendments is requested.

Turning now to the prior art rejections, in the third section of the Office Action, the Examiner has rejected claims 1, 2 and 10 under 35 U.S.C. § 102(b) as being anticipated by (U.S. Patent No. 4,224,364). Also, claim 1 is rejected as being anticipated by Smith (U.S. Patent No. 1,956,161). In the fourth section of the Office Action the Examiner has rejected claims 3, 4, 5, 6,

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7, 8, 9, 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent No. 1,956,161 in view of the Faberge Elephant Egg (hereinafter referred to as the “egg reference”).

Applicant respectfully disagrees with the Examiner’s contentions and respectfully submits the following remarks in response.

The present invention as claimed in independent claim 1 is directed to a glass ornament having a first top module constructed of mouth blown thin-walled blown glass as well as a second bottom module also constructed of mouth blown thin-walled glass. The first top and second bottom modules are dimensionally and spatially correlated in a connection plane that when closed together form the ornament, where at least one of said first top and second bottom modules is of a shell construction.

In this arrangement a new and novel ornament has been constructed where a single ornament is constructed of two correlated modules, *where both modules are constructed of thin-walled blown glass*. In the field of ornaments, such as Christmas ornaments a number of construction types are known. Among these designs, glass versions of such ornaments, are typically broken down into two types, thin-walled and thick walled (crystal). Thick walled or crystal glass ornaments have a large lead component, have a substantial weight, and are suitable for etching or engraving of designs.

Mouth blown thin-walled glass refers to a different type of glass that is mouth (hand) blown from a glass tube and which, when annealed, produces a delicate and easily shattered product. Prior art ornaments formed from mouth blown thin-walled glass typically are formed as a single piece hollow ornament such as ball or simple shape. Additionally prior art methods for mouth blown thin-walled glass ornaments have multiple elements *but* each element is in itself a

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closed item, where the multiple elements are simply glued or attached to one another to form the larger single ornament.

The present invention provides a novel ornament that is both formed of mouth blown thin-walled glass, where two halves (modules) are closed to form a single ornament. Such construction of a single ornament from two mouth blown thin walled glass modules is not known in the prior art.

Turning now to the prior art, Hunt teaches a Christmas ornament that is made of a globe construction with two opposable transparent hemispheres for supporting a picture or the like so that they may be viewed therethrough. However, as noted in column 4, lines 3-15:

“The hemispheres 11 and 12 are preferably transparent and may be made from glass or any suitable transparent plastic for use as a display container. A satisfactory container has been made, for example, from polycarbonate or LEXAN (a trademark of the General Electric Company) having a wall thickness of about 1/16 of an inch. The assembled container was three inches in diameter. LEXAN has *the desirable property of being extremely tough and virtually unbreakable in ordinary use. When made of such durable material the display container has additional utility as a package for delivery of its contents.* Of course, one or both of the housing sections may be opaque or translucent, as desired.” (emphasis added)

As such, Hunt does not teach the use of mouth blown thin-walled glass for the construction of either module. In fact, assuming glass replaces the desired LEXAN, Hunt teaches away from using thin-walled glass as the intention of Hunt is to have the hemispheres be nearly indestructible, most likely using heavy (possibly machine blown) glass.

In view of this, Applicant respectfully submits that Hunt does not teach or suggest all of the elements of the present invention as claimed, nor could such reference be modified as such to include the claimed thin-walled blown glass, and request that this rejection be withdrawn.

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The Smith reference is directed to glass “canteen” globe construction typically used for gas pump tops in the 1930’s and 40’s. In order to address the issue of the paint wearing off of the globes, Smith proposed a construction where by a single globe was broken into two halves, the insides are etched or sand blasted with a design on the inside surface (page 1, lines 22-25) and then the halves are rejoined. Thus, the final product has the design on the interior of the glass globe, secured from the elements.

For similar reasons as discussed above in view of Hunt, it is evident that Smith is using commercial heavy glass, capable of etching or sand blasting. Such techniques would easily destroy an ornament constructed of mouth blown thin-walled glass.

In view of this, Applicant respectfully submits that Smith does not teach or suggest all of the elements of the present invention as claimed, nor could such reference be modified as such to include the claimed thin-walled blown glass, and request that this rejection be withdrawn.

Finally, the egg reference is a recreation in glass of the original Faberge Elephant Egg. The original Faberge Elephant Egg was constructed of Gold. The replica shown in the egg reference is construct of thick-walled glass crystal. This is evidenced by the etchings on the glass. Such etchings are not possible on mouth blown thin-walled glass. In fact, the egg reference can not be modified to thin-walled glass as it would no longer be able to receive the etchings.

In view of this, Applicant respectfully submits that neither the Hunt nor Smith references, either alone (as noted above) or in combination with the egg reference teach or suggest all of the elements of the present invention as claimed, nor could such references be modified as such to include the claimed thin-walled blown glass, and request that this rejection be withdrawn.

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In view of the foregoing, Applicant respectfully submits that pending claims 1-12 are in condition for allowance, the earliest possible notice of which is earnestly solicited. If the Examiner feels that an interview would facilitate the prosecution of this Application he is invited to contact the undersigned at the number listed below.

Respectfully submitted,

~~SOFER & HAROUN, L.L.P.~~

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